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DEC 05 2008

**OFFICE OF PETITIONS**

In re Application of :  
Kidd et al. :  
Application No. 09/805,839 :  
Filed: 03/13/2001 :  
Attorney Docket No. 21275-001 :  
DECISION ON PETITION

This is a decision on the "Petition To Withdraw Notice of Abandonment or in the Alternative To Revive Under 37 CFR § 1.137(a) or § 1.137(b)" filed July 21, 2008.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **DISMISSED**.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

On May 2, 2007, the Office mailed a Notice to File Missing Parts of Nonprovisional Application, which set a two-month extendable period to submit an executed oath or declaration, replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121(d), and a \$65.00 surcharge. On Monday, December 3, 2007, applicants filed a reply accompanied by a request for an extension of time for response within the fifth month. On December 26, 2007, the Office mailed a Notice of Incomplete Reply (Nonprovisional) stating that the response filed on May 2, 2007, did not include the required replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) and that the period of reply remained as set forth in the Notice to File Missing Parts of Nonprovisional Application. As no complete and timely reply was filed, the application became abandoned on December 3, 2007. On February 22, 2008, applicants submitted a reply to the Notice to File Missing Parts of Nonprovisional Application. On May 1, 2008, the Office mailed a Notice of Abandonment advising applicants that the application was abandoned and that the reply received on February 22, 2008, was untimely.

On July 21, 2008, applicants filed the present petition to withdraw the holding of abandonment, or in the alternative, to revive the application under 37 CFR 1.137(a) or 37 CFR 1.137(b). Applicants assert that their reply filed on December 3, 2007, was a substantially complete reply and a bona fide attempt to respond to the Notice to File Missing Parts of Nonprovisional Application. Applicants state that to the extent compliance with some requirement was inadvertently omitted, they request that the Office

provide a new time period for reply to supply the omission and enter and consider the response filed on February 22, 2008.

### **PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT (37 CFR 1.181)**

The Office is not persuaded by applicants' argument that the reply was substantially complete and constituted a bona fide attempt to reply to the Notice to File Missing Parts of Nonprovisional Application. As set forth in 37 CFR 1.135(c), when reply by an applicant is determined to be a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, an applicant may be given a new time period for reply under § 1.134 to supply the omission. See 37 CFR 1.135(c). 37 CFR 1.135(c) does not require that an examiner give an applicant a new time period to reply. However, in this instance, the provisions of 37 CFR 1.135(c) do not apply. As the reply was in response to a Notice to File Missing Parts of Nonprovisional Application, no additional time period will be given beyond that set in the Notice. As stated in the Notice of Incomplete Reply, the time for filing a proper reply continues to run. The Office reminds applicants that it is ultimately the responsibility of the applicant to file a timely, complete and proper reply to an outstanding Notice or Office communication to avoid abandonment of the application. While the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation due such in a manner permitting a timely correction. See In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994).

As the application is in fact abandoned, the petition under 37 CFR 1.181 to withdraw the holding of abandonment must be dismissed.

### **PETITION UNDER 37 CFR 1.137(a)**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The required reply to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The present petition does not meet requirement (3).

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable". 35 U.S.C. § 133. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

A delay is not unavoidable when an applicant fails to comply with a requirement set forth in an Office communication, which necessitates a response within a specified time period. Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987); Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

As applicants have not provided a sufficient showing to the satisfaction of the Director that the entire delay was unavoidable, the petition under 37 CFR 1.137(a) must be dismissed.

#### **PETITION UNDER 37 CFR 1.137(b)**

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply

until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and,

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to 37 CFR 1.137(d)

37 CFR 1.137(b)(3) requires a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional” be submitted. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Applicants must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

Applicants have met the requirements under 37 CFR 1.137(b). Applicants submitted the required reply, an authorization to charge the petition fee, and an acceptable statement of unintentional delay. Accordingly, the petition under 37 CFR 1.137(b) is **GRANTED**.

The \$255.00 fee for filing a petition under 37 CFR 1.137(a) and the \$770.00 fee for filing a petition under 37 CFR 1.137(b) will be charged to the Deposit Account as authorized.

This application is being referred to the Office of Patent Application Processing for pre-examination processing.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

*C. T. Donnell*

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